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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,381	10/14/2004	Steven M. Kessell	205332-9011-01	2105
1131 7590 05/20/2008 MICHAEL BEST & FRIEDRICH LLP Two Prudential Plaza 180 North Stetson Avenue, Suite 2000 CHICAGO, IL 60601				
EXAMINER				
QUINN, COLLEEN M				
ART UNIT		PAPER NUMBER		
3634				
MAIL DATE		DELIVERY MODE		
05/20/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/511,381

**Applicant(s)**

KESSELL ET AL.

**Examiner**

COLLEEN M. QUINN

**Art Unit**

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 20-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 and 20-56 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The Examiner apologizes for a Restriction Requirement at this point in the prosecution. Previously the examiner was not aware of how burdensome the extended search for various inventions would become, and did not realize the need for a restriction until further review of the application. In reviewing the numerous claim groupings and claimed inventions the examiner felt that the search for all of the inventions together was too burdensome and in order to properly search and determine the patentability of each invention the Examiner is now requiring a restriction. She notes that after election, the office action will NOT be made final.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 drawn to a modular shelving system classified in class 211, subclass 189,
- II. Claims 9-17 drawn to a method of mounting cantilevered shelves to a support post classified in class 211 subclass 187,
- III. Claims 18, 20 and 21 drawn to a post classified in class 211, subclass 86.01,
- IV. Claims 22-32 drawn to a method for supporting cantilevered shelved classified in class 211, subclass 187,
- V. Claims 33-39 drawn to another detailed modular shelving system classified in class 211, subclass 189,

- VI. Claims 40-48 drawn to a differently detailed modular shelving system classified in class 211, subclass 186,
- VII. Claims 49-54 drawn to a cantilevered shelf classified in class 211, subclass 134, and
- VIII. Claims 55-56 drawn to a method of supporting a cantilevered shelf classified in class 211, subclass 187.

The above listed inventions are distinct, each from the other because of the following reasons:

The inventions are directed to related inventions and methods. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a *materially different design, mode of operation, function, or effect*; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are each different from the other.

Invention I is distinct from other inventions, such as Invention II, since it requires two posts, each post having laterally extending connectors and shelves extending between the posts and the shelves having a plurality of brackets and a cross member.

Invention II is distinct from the others since it is a method for mounting cantilevered shelves and only one post is required and the shelves do not require

brackets or certain cross members and the method can construct a materially different shelf than the apparatus claims.

Invention III is distinct since the invention claims only a post with welded connectors and no shelves.

Invention IV is distinct since it is a method and requires third and forth releasable connectors on the shelves and can create a materially different shelf than the other apparatuses.

Invention V is distinct since it requires only one post and the shelves do not require brackets or connectors and both shelves extend forward of the post.

Invention VI is distinct since it requires only one post and the shelves do not require brackets or connectors and one of the shelves extends in front of the post and one extends rearward of the post.

Invention VII is distinct since it requires only a cantilevered shelf and the shelf has flanges designed to extend laterally across a portion of a post.

Invention VIII is distinct since it is a method for supporting a cantilevered shelf requiring two posts and can create a materially different shelving assembly than the other apparatuses.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement

will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was not made to applicant's representative to request an oral election to the above restriction requirement, due to the large number of inventions claimed and numerous claim groupings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to COLLEEN M. QUINN whose telephone number is (571)272-6289. The examiner can normally be reached on 8:30AM-5:00PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on (571) 272-7069. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHERINE W MITCHELL/  
Supervisory Patent Examiner, Art Unit 3634

/C. M. Q./  
Examiner, Art Unit 3634



**Application Number****Application/Control No.**

10/511,381

**Applicant(s)/Patent under  
Reexamination**

KESSELL ET AL.

**Examiner**

COLLEEN M. QUINN

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3634